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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,534	06/14/2001	Garro J. Derderian	MI22-1752	8714

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SUITE 1300  
SPOKANE, WA 99201-3828

EXAMINER

THOMAS, TONIAE M

ART UNIT	PAPER NUMBER
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2822

14

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/882,534	Applicant(s) DERDERIAN ET AL.	
	Examiner Toniae M. Thomas	Art Unit 2822	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2, 13</u> | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 December 2002 has been entered.
2. The amendment received on 10 December 2002 added claims 50 and 51. Currently, claims 32-51 are pending.
3. The indicated allowability of claims 32-35, 38, and 40-49 is withdrawn in view of the newly discovered reference(s) to Lee (US 6,355,519 B1). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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*Claims 36, 38, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US 6,355,519 B1).*

Lee discloses a capacitor construction (fig. 2 and accompanying text). The capacitor construction comprises the following elements: a first capacitor electrode 17 over a substrate 11 (fig. 2); an insulative barrier layer to oxygen 21 over the first electrode (fig. 2), the barrier layer comprising a chemisorption product of first and second precursor monolayers (col. 4, line 63 to col. 5, line 10); a capacitor dielectric layer 23 over the first electrode (fig. 2); a second capacitor electrode 25 over the dielectric layer and the barrier layer (fig. 2).

The first precursor monolayer is the layer formed during the first stage (col. 4, line 63 to col. 5, line 3), and the second precursor monolayer is the layer formed at the second stage (col. 5, lines 3-10).

The barrier layer comprises  $\text{Al}_2\text{O}_3$ , which exhibits a dielectric constant K of greater than about 7 at 20°C (col. 4, lines 61-62).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 32-35, 37, and 40-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee.*

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Lee discloses a capacitor construction (fig. 2 and accompanying text). The capacitor construction comprises the following elements: a first capacitor electrode 17 over a substrate 11 (fig. 2); a capacitor dielectric layer 23 over the first electrode (fig. 2); a second capacitor electrode 25 over the dielectric layer (fig. 2); and an insulative barrier layer 21 to oxygen between the first and second electrodes (fig. 2).

The barrier layer comprises  $\text{Al}_2\text{O}_3$ , which exhibits a dielectric constant K of greater than about 7 at 20°C (col. 4, lines 61-62).

The barrier layer comprises a chemisorption product of first and second precursor monolayers (col. 4, line 63 to col. 5, line 10). The first precursor monolayer is the layer formed during the first stage (col. 4, line 63 to col. 5, line 3), and the second precursor monolayer is the layer formed at the second stage (col. 5, lines 3-10).

A "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Applicant has the burden of proof in such cases, as the above case law makes clear. Hence, the process

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limitation "atomic layer deposited" as recited in claims 32, 40, and 45 has not been examined.

Lee teaches that during the first stage of forming the barrier layer, the layer is deposited to a thickness of less than 20 Å (col. 4, lines 63-66). However, Lee does not teach that the barrier layer has a thickness of less than about 12 Å. Given the general process disclosed in the prior art, it would have been within the ability of one having ordinary skill in the art to discover the claimed range of thickness through routine experimentation. "Where general conditions of [a] claim are disclosed in prior art, it is not inventive to discover optimum or workable ranges by routine experimentation" (see *In re Aller, Lacey, and Hall* 105 USPQ 233 (CCPA 1955)). Therefore, the claimed thickness is taken to be obvious over Lee.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toniae M. Thomas whose telephone number is (703) 305-7646. The examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on (703) 308-4905. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

TMT

December 26, 2002



AMIR ZARABIAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800